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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,943	05/31/2000	Michael Wayne Brown	AUS000047US1	4372

7590

06/02/2003

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EXAMINER

PASS, NATALIE

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 06/02/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/583,943

Applicant(s)

BROWN ET AL.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9,11-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9,11-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 19 March 2003. Claims 1-68 remain pending. Claims 1, 13, 14 and 27 have been amended. Claims 10, 67, and 68 have been canceled.

Specification

2. The objection to the abstract of the disclosure because of undue length is hereby withdrawn due to the amendment filed 19 March 2003.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 10-12, 14-17, 23-25, 27-30, 36-38, 40-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond et al, U.S. Patent Number 5, 778, 882 in view of Trudeau et al, U.S. Patent Number 5, 980, 447 for substantially the same reasons given in the prior Office Action (paper number 3). Further reasons appear hereinbelow.

(A) Claims 1, 14, and 27 have been amended to include the recitation of "[...] automatically monitoring [...]" at line 3, and "[...] presenting the prioritized plurality of actions for selection by said particular user [...]" at line 10, and "[...] determining a priority level at which sufficient allowances are available for each of said plurality of actions in view of said designated allowances, wherein said designated allowances includes at least one type of allowances from among time allowances, financial allowances, and health allowances [...]" at lines 13-17.

As per these new limitations, Raymond and Trudeau teach a method, a system, and a program as analyzed and disclosed in the previous Office Action (paper number 3), further comprising:

automatically monitoring current health parameters for a particular user at a personal health monitoring system, wherein said current health parameters includes a plurality of monitored physical parameters and a plurality of monitored environmental parameters (Raymond; see at least Figures 17, 18, 19, 19A, column 1, lines 42 to column 2, line 60, column 5, lines 30-44, column 28, lines 37-49);

presenting the prioritized plurality of actions for selection by said particular user, such that said personal health monitoring system, aids said particular user in selecting from among said plurality of actions in order to balance the comprehensive health of said particular user (Trudeau; Figure 1, Items 10, 12, Figure 2, Item 22, Figure 3, Item 37, column 5, lines 13-26, column 6, lines 50-64, column 9, lines 5-15, column 9, line 66 to column 10, line 35, column 10, line 50-61, column 16, line 64 to column 17, line 5), (Raymond; column 25, lines 35-46); and

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determining a priority level at which sufficient allowances are available for each of said plurality of actions in view of said designated allowances, wherein said designated allowances includes at least one type of allowances from among time allowances, financial allowances, and health allowance (Trudeau; column 5, lines 13-55, column 6, lines 55-64, column 11, lines 47-63, column 12, lines 4-46)

The remainder of claims 1, 14, and 27 are rejected for the same reasons given in the prior Office Action (paper number 3, section 4, pages 2-4, 6), and incorporated herein.

(B) Claims 2-4, 11-12, 15-17, 23-25, 28-30, 36-38, 40-66 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 3, section 4, pages 4-11), and incorporated herein.

5. Claims 5-7, 18-20, 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond et al, U.S. Patent Number 5, 778, 882 and Trudeau et al, U.S. Patent Number 5, 980, 447 as applied to claims 1, 14, and 27 above, and further in view of Goldman et al, U.S. Patent Number 5, 542, 420 for substantially the same reasons given in the prior Office Action (paper number 3). Further reasons appear hereinbelow.

(A) Claims 5-7, 18-20, 31-33 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 3, section 5, pages 12-14), and incorporated herein.

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6. Claims 8, 21, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond et al, U.S. Patent Number 5, 778, 882 and Trudeau et al, U.S. Patent Number 5, 980, 447 as applied to claims 1, 14, and 27 above, and further in view of Diaz et al, U.S. Patent Number 5, 890, 128 for substantially the same reasons given in the prior Office Action (paper number 3). Further reasons appear hereinbelow.

(A) Claims 8, 21, and 34 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 3, section 6, pages 14-15), and incorporated herein.

7. Claims 9, 22, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond et al, U.S. Patent Number 5, 778, 882 and Trudeau et al, U.S. Patent Number 5, 980, 447 as applied to claims 1, 14, and 27 above, and further in view of Gulf Goans' Mailing List Newsletter, GOA-WORLD - WEEKEND POST NEWSLETTER - VOLUME XIII - 25 NOVEMBER 1998, <http://www.goa-world.net/gulf_goans/nov31.htm>, hereinafter known as Goans Listserv, for substantially the same reasons given in the prior Office Action (paper number 3). Further reasons appear hereinbelow.

(A) Claims 9, 22, and 35 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 3, section 7, pages 15-16), and incorporated herein.

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8. Claims 13, 26, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond et al, U.S. Patent Number 5, 778, 882 and Trudeau et al, U.S. Patent Number 5, 980, 447 as applied to claims 1, 14, and 27 above, and further in view of Notes.Net Filtering Article, 1999, < [http://www-10.lotus.com/ldd/today.nsf/62f62847467a8f78052568a80055b380/4541559cb15c46e285256815007b107d/\\$FILE/mailrule.pdf](http://www-10.lotus.com/ldd/today.nsf/62f62847467a8f78052568a80055b380/4541559cb15c46e285256815007b107d/$FILE/mailrule.pdf)>, hereinafter known as Filtering Article for substantially the same reasons given in the prior Office Action (paper number 3). Further reasons appear hereinbelow.

(A) As per the amendment to claim 13 this appears to have been made merely to correct errors in the claim language. While this change renders the language of the claim smoother and more consistent, it otherwise affects neither the scope and breadth of the claim as originally presented nor the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 3, section 8, pages 16-17), incorporated herein, and as discussed above in the rejection of amended claim 1, and also incorporated herein.

(B) Claims 26, and 39 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 3, section 8, pages 16-17), and incorporated herein.

Response to Arguments

9. Applicant's arguments filed 19 March 2003. have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 19 March 2003.

(A) At page 19 of the 19 March 2003 response, Applicant argues that the claim limitations in the 31 May 2000 Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of the cited references, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 3), and incorporated herein. In particular, Examiner notes that the limitations of prioritizing or ranking "said plurality of actions according to said current health parameters and designated allowances for said particular user at said personal health monitoring system" are taught by the combination of cited references. Specifically, it was the teachings of Trudeau that were relied upon for disclosing prioritizing or ranking said plurality of actions according to said current health parameters and designated allowances for said particular user at said personal health monitoring system (Trudeau; column 5, lines 21-26, column 10, line 50-61). Trudeau's system relies upon "user defined profiles" defined through "test results and the incorporation of options and selections into the system" (Trudeau; column 4, lines 40-44) which

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reads on "current health parameters and designated allowances for said particular user at said personal health monitoring system". Trudeau teaches an "Expert System Adaptive to User Profile And Choices" (Trudeau; Figure 2, Figure 6, Items 60, 56). As well Trudeau's invention provides "new strategies and mechanisms ...[...]" to assist the user including "massive amounts of specific, targeted, and productive information which is custom configured for the [particular] individual [...user...] profile" (Trudeau; column 4, lines 44-59). Additionally, in Trudeau's invention the computer presents a menu of choices for the user to establish a user profile and responds to the user profile of the particular user by proposing to the user a strategy of action appropriate for the user's profile (Trudeau; column 5, lines 43-60). As such, the Examiner respectfully submits that the ranking or prioritization of actions occurs as a function of current health parameters and designated allowances for said particular user.

(B) At page 20 of the 19 March 2003 response, Applicant argues that the claim limitations in the 31 May 2000 Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of the cited references, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 3), and incorporated herein. In particular, Examiner notes that the limitations of "determining a priority level at which sufficient allowances are available for each of said plurality of actions in view of said designated allowances, wherein said designated

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allowances includes at least one type of allowance from among time allowances, financial allowances, and health allowances" are taught by the combination of cited references.

To the extent that the Examiner understands "determining a priority level at which sufficient allowances are available for each of said plurality of actions in view of said designated allowances, wherein said designated allowances includes at least one type of allowance from among time allowances, financial allowances, and health allowances", ranking or prioritizing potential actions from a list of possible actions according to a particular user's profile or database as well as current parameters and then determining or suggesting suitable actions according to the priority levels assigned to the actions is taught by Trudeau (Trudeau; column 5, lines 13-55, column 6, lines 55-64, column 11, lines 47-63, column 12, lines 4-46). In Trudeau's invention the computer establishes a user profile and responds to the user profile of the particular user at the particular time by proposing to the user a strategy of action from a list of possible actions appropriate for the user's profile (Trudeau; column 5, lines 43-60, column 9, lines 5-41). Trudeau's system compiles recommendations from the user's profiles and other baseline data and incorporates an "expert system to recommend certain remedial actions in response to these parameters" (Trudeau; column 10, lines 50-65). These actions include direction of the user to tools or actions most capable of lowering distress or altering the health problem or fitting within designated allowances and include other recommendations depending upon the nature of the crisis. The system "ranks the available tools in a simple progression of stress reducing actions" (Trudeau; column 10, lines 50-65). Examiner notes that an expert system that recommends actions based on specific parameters includes the determination of a priority level at which sufficient allowances are available for each of the potential actions in order to make the

recommendation. As such, the Examiner respectfully submits that determining a priority level at which sufficient allowances are available for each of said plurality of actions in view of said designated allowances, wherein said designated allowances includes at least one type of allowance from among time allowances, financial allowances, and health allowances is taught by the applied references.

(C) At page 21 of the 19 March 2003 response, Applicant argues that the claim limitations in the 31 May 2000 Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of the cited references, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 3), and incorporated herein. In particular, Examiner notes that the limitations of "selecting suitable times for scheduling said plurality of tasks in view of said current health parameters and designated allowances for said particular user at said personal health monitoring system, such that said personal health monitoring system aids said particular user in scheduling tasks in order to balance the comprehensive health of said particular user" are taught by the combination of cited references (Trudeau; column 5, lines 21-26, column 10, line 50-61). Trudeau's system assists in selecting suitable times for scheduling the mastering of recovery tools or tasks in view of current health parameters, including scheduling options for meetings, workshops and suggested personal therapy tasks (Trudeau; Figure 7, Figure 8, Figure

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10, column 4, lines 26-36, column 12, line 63 to column 14, line 9). As such, the Examiner respectfully submits that "selecting suitable times for scheduling said plurality of tasks in view of said current health parameters and designated allowances for said particular user at said personal health monitoring system, such that said personal health monitoring system aids said particular user in scheduling tasks in order to balance the comprehensive health of said particular user" is taught by the applied references

(D) At pages 19-22 of the 19 March 2003 response, Applicant analyzes the applied references separately and argues each of the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071,

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5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Raymond's method of monitoring health parameters to include Trudeau's invention, which includes prioritizing and scheduling tasks for improving personal health, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 3) with the motivation of ranking in frequency and duration of use, as well as timing and scheduling, the mastering of personal health or recovery tools as well as the tracking and recording of a subject's progress in achieving balanced personal health or recovery, of establishing obtainable goals and during that process, providing both quantitatively and qualitatively measurable progress, and of generating a change environment for balanced personal health or recovery by including interaction between the user and the process utilizing user defined profiles through test results and the incorporation of options and selections into the system (Trudeau; column 4, lines 26-44).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

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In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

Conclusion

10. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

(703) 305-7687.

For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

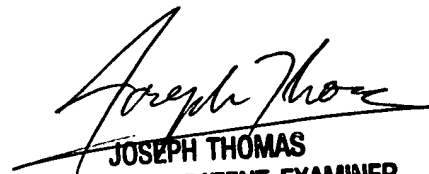
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

NP

Natalie A. Pass

May 27, 2003


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600